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REMARKS

In the Office Action mailed May 24, 2004, the Examiner rejected claims 8 and 23 under 35 U.S.C. §112, second paragraph. The Examiner next rejected claim 1 under 35 U.S.C. §102(b) as being anticipated by Hube et al. (USP 5,442,541). Claims 3, 9-10, 12, and 14-16 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Hube et al. Claims 2, 4-5, 8, 17-19, and 21-23 were rejected under 35 U.S.C. §103(a) as being unpatentable over Hube et al. in view of Moeller (USP 6,694,384). Claim 6 was rejected under 35 U.S.C. §103(a) as being unpatentable over Hube et al. in view of Moeller, and further in view of Duncan Jr. (USP 5,259,029). The Examiner rejected claim 11 under 35 U.S.C. §103(a) as being unpatentable over Hube et al. in view of Duncan Jr and rejected claim 7 under 35 U.S.C. §103(a) as being unpatentable over Hube et al. in view of Moeller, and further in view of Amini et al. (USP 6,698,021). Claim 20 was rejected under 35 U.S.C. §103(a) as being unpatentable over Hube et al. in view of Moeller, and further in view of Applicant's Admitted Prior Art (AAPA). Claims 13, 24-25, and 28 stand rejected under 35 U.S.C. §103(a) as being obvious over Hube et al. in view of AAPA. Claims 26-27 and 29 were rejected under 35 U.S.C. §103(a) as being unpatentable over Hube et al. in view of AAPA, and further in view of Moeller et al.

The Examiner rejected claim 8 under 35 U.S.C. §112, second paragraph, for insufficiently providing antecedent basis for "the software key." Applicant has amended claim 8 to depend from claim 2 to provide antecedent basis.

The Examiner also rejected claim 23 under 35 U.S.C. §112, second paragraph, for insufficiently providing antecedent basis for "wherein the." Applicant has amended claim 23 to call for the computer data signal of claim 17 wherein the GUI is configured to allow selection of one of a trial use period, a limited use period, a pay-per-use period, and an indefinite use period for the inactive option.

By these amendments to claims 8 and 23, Applicant believes these claims comply with the statutory provisions of 35 U.S.C. §112 and, thus, are in condition for allowance.

The Examiner rejected claim 1 under 35 U.S.C. §102(b) as being anticipated by Hube et al. Applicant has amended claim 1 to incorporate the subject matter of claim 7. While the subject matter of claim 7 was not indicated as allowable, it is believed that Hube et al. fails to teach that called for in amended claim 1.

Regarding amended claim 1, the Examiner rejected that called for in claim 7 under 35 U.S.C. §103(a) as being unpatentable over Hube et al. in view of Moeller, and further in view of

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Amini et al. In setting forth the rejection of claim 7, the Examiner concluded that "[a]s for the transmission of the software key being via a private communication interface, such that the private communication interface electronically connects the centralized facility to the device, Hube-Moeller is silent on such different communication interfaces for transmission." Office Action, p. 19. The Examiner further stated that "Amini discloses a means of public and private communication interfaces for transmission of data for the enablement of monitoring...." *Id.*

Applicant does not dispute the Examiner that Hube et al. and Moeller et al. fail to teach or suggest different communication interfaces for transmission. Hube et al. teaches "[a] communication modem 182 [that] is provided for machine 30 at the machine site, modem 182 serving to connect line 175 to machine 30 for transmittal of the machine physical data from machine 30 to the remote host 157 and reconfiguration data from remote host 157 to machine 30." Col. 10, lns. 39-44. Hube et al. further teaches "[a] communication modem 182 is provided for machine 30 at the machine site, modem 182 serving to connect line 175 to machine 30 for transmittal of the machine physical data from machine 30 to the remote host 157 and reconfiguration data from remote host 157 to machine 30." Col. 10, lns. 44-48. Hube et al. does not differentiate between private and public communications between machine 30 and the remote host 157. The cited reference simply teaches a single communication between machine 30 and the remote host 157. Hube et al. fails to teach or suggest that an electronic request is transmitted via a public communication interface and that a software key is transmitted via a private communication interface. Additionally, Hube et al. fails to teach that a private communication interface electronically connects the centralized facility to the device.

The Examiner combined Moeller et al. with Hube et al. in making the rejection of claim 7. Moeller et al. teaches that a "scanner company can install changes into any one or all of the software layers via a system configuration port 30 operatively connected via the Internet 20 or a download application 25 to the scanning PC workstation (PC) 10." Col. 3, lns. 59-63. A user "receives an access key or access code 140 to enter into the scanner for the scanner to configure itself by enable the features selected, and disabling the unselected features when necessary." Col. 4, lns. 41-45. Moeller further teaches that "[t]he access key 140 is entered into the limited feature scanner 50 either by the user via an alphanumeric keypad on the scanner or via the workstation keypad, or by sending a code or file of information to be loaded into the PC workstation." Col. 4, lns. 46-50. In particular, Moeller et al. clearly teaches that the system configuration port 30 is connected to the scanning PC workstation 10 -- not to the device having features to be enabled. Additionally, Moeller et al. fails to teach or suggest that an electronic request is transmitted via a

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public communication interface and that transmission of a software key is via a private communication interface, such that the private communication interface electronically connects the centralized facility to the device as called for in amended claim 1.

The third reference relied upon by the Examiner in the rejection of claim 7, Amini et al., "relates to video surveillance and monitoring systems, and more particularly, to video surveillance and monitoring systems that stores video image data in an off-site storage site." Col. 1, lns. 8-11. Amini et al. teaches that a "video surveillance and monitoring environment 300 includes a client site 310, a viewing site 320, and an off-site storage site 330." Col. 4, lns. 58-60. Amini et al. further teaches that "communication between client workstation 322 and off-site server 332 is operative over public Internet 350." Col. 5, lns. 23-25. Security cameras 312 included in client site 310 "acquire video image data for transmission to off-site storage site 330 via a private network 340." Col. 4, lns. 60-63.

According to the Examiner, "[i]t would have been obvious to one of ordinary skill in the art to combine the teachings of Amini with the Hube-Moeller combination because it would have provided flexibility of enabling the selected options as well as adding security to the communication of the software key." Applicant respectfully disagrees.

MPEP §2142 states that "[t]he burden of establishing a *prima facie* case of obviousness falls on the Examiner." Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). Accordingly, to establish a *prima facie* case, the Examiner must not only show that the combination includes each and every element of the claimed invention, but also provide "a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). That is, "[o]bviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art." MPEP §2143.01. "The fact that references can be combined or modified is not sufficient to establish *prima facie* obviousness." Id. When prior art references require a selected combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gained from the invention itself, i.e., something in the prior art as a whole must suggest the desirability, and thus the obviousness, of

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making the combination. *Uniroyal Inc. v. Rudkin-Wilcy Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988).

Applicant believes that a *prima facie* case of obviousness has not been established and one cannot be made based on the art of record. To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. MPEP §2143

Applicant believes that a *prima facie* case of obviousness cannot be made based on the art of record because the references are directed to very different purposes and there is no motivation to combine these references in a way done so by the Examiner, other than Applicant's own teaching. In short, the Examiner has not established the criteria required to sustain an obviousness rejection under MPEP §2143.

MPEP §2141 further states "the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention" Simply, "one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." (*In re Fritch*, 972 F.2d 1260, 23 USPQ 2d, 1780, 1784 (Fed. Cir. 1992) citing *In Re Fine*, 837 F.2d, 1071, 1075, 5 USPQ 2d, 1596, 1600 (Fed. Cir. 1988)). It is apparent that the Examiner has combined the references to form the rejection solely using the hindsight benefit of the claims and the present invention. That is, the Examiner has combined Amini et al., directed to a system for enabling real-time off-site video image storage, with Hube et al., directed to a method of activating disabled features on a device connected to a remote location, and Moeller et al., directed to a method of activating disabled features on a device not connected to a remote location. The Examiner has impermissibly used individual elements of unrelated references as a guide. One skilled in the art of enabling disabled features on a device connected directly to a remote location would not look to a video surveillance and monitoring system, absent the teaching of the Applicant, to incorporate an electronic request transmitted via a public communication interface and a software key transmission via a private communication interface. The Examiner has used Applicant's teaching as the basis to combine the prior art.

The Examiner has concluded that one skilled in the art would be motivated to combine the teachings of Hube et al., Moeller et al., and Amini et al. in that Amini et al.'s private communication network provides flexibility of enabling the selected options as well as adding security to the communication of the software key. However, the motivation to combine the references must come from the references themselves. MPEP §2143. There is no disclosure in

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Hube et al. or Moeller et al. for adding security to the communication of the software key using different modes of public and private communications. Therefore, the references do not provide the suggestion or motivation to combine the references in the manner suggested by the Examiner. Additionally, assuming existence of a motivation to combine as discussed above, the references fail to teach each and every element of claim 1.

As such, at least for the reasons set forth above, that which is called for in claim 1 is not shown or disclosed in the art of record nor do the references suggest or motivate the combination suggested by the Examiner. Therefore, claim 1 and those claims that depend therefrom, are patentably distinct over the art of record.

The Examiner rejected claim 9 under 35 U.S.C. §103(a) as being unpatentable over Hube et al. Applicant has amended claim 9 to incorporate the subject matter of claim 14. Regarding the rejection of claim 14, the Examiner stated that "[s]uch identifying of machines in a communications network is well known in the art to include entering a host ID (such as a network address) or ID linking a location to the device. One of ordinary skill in the art at the time of the applicant's invention would have realized such a entering of a host ID in order for proper locating of the machine on the network." However, amended claim 9 calls for, in part, a computer programmed to receive a host ID input wherein the host ID corresponds to a physical location of the device not an intangible location on a communications network. Hube et al. does not teach or suggest to one skilled in the art that a communications network address of the device or an ID linking the device to an intangible location on the communications network indicates the physical location of the device.

As such, at least for the reasons set forth above, that which is called for in claim 9 is not shown or disclosed in the art of record. Therefore, claim 9 and those claims that depend therefrom, are patentably distinct over the art of record.

The Examiner rejected claim 17 under 35 U.S.C. §103(a) as being unpatentable over Hube et al. in view of Moeller. Applicant has amended claim 17 to incorporate the subject matter of claim 18 to further define the present invention. Amended claim 17 calls for, in part, a computer data signal embodied in a carrier wave and representing a sequence of instructions which, when executed by at least one processor, causes the at least one processor to display a GUI configured to facilitate a request over a first communication interface to enable an inactive option resident on a remote device and to transmit the code to the device over a second communication interface having the inactive option. As stated above, Hube et al. fails to teach or suggest multiple communication modes for receiving a device feature enabling request and for

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transmitting code to enable the device feature. Similarly, Moeller et al. fails to teach or suggest more than one type of communication interface for receiving an option enabling request and for transmitting the enabling code or transmitting the code to the device. In fact, Moeller et al. teaches transmitting the enabling key to the workstation PC 10 -- not the device itself.

As such, at least for the reasons set forth above, that which is called for in claim 17 is not shown or disclosed in the art of record. Therefore, claim 17 and those claims that depend therefrom, are believed patentably distinct over the art of record.

The Examiner rejected claim 24 under 35 U.S.C. §103(a) as being obvious over Hube et al. in view of Applicant's Admitted Prior Art. Applicant has amended claim 24 to further define the present invention. Amended claim 24 calls for, in part, a GUI to request activation of an inactive software program resident in memory of a medical imaging scanner remotely located from a centralized processing center comprising a software key generation tab, whereupon user selection of the software key generation tab transmits a data transmission over a public communication connection to the centralized processing center, and wherein the data transmission represents a request to activate the inactive software program resident in memory of the medical imaging scanner over a private communication connection. Referring to that stated above, Hube et al. fails to teach or suggest multiple communication connections for transmitting data over a public communication connection and for activating the inactive software program resident in memory of the medical imaging scanner over a private communication connection. Similarly, Applicant's Admitted Prior Art fails to teach or suggest multiple communication connections for transmitting data over a public communication connection and for activating the inactive software program resident in memory of the medical imaging scanner over a private communication connection.

As such, at least for the reasons set forth above, that which is called for in claim 24 is not shown or disclosed in the art of record. Therefore, claim 24 and those claims that depend therefrom, are believed patentably distinct over the art of record.

Applicant has canceled claims 7, 14, and 18 and presents claims 30 and 31 as new claims herein. Claims 30 and 31 depend from claims 9 and 17, respectively. Applicant believes that claims 30 and 31 are patentably distinct over the art of record pursuant to at least the chain of dependency.

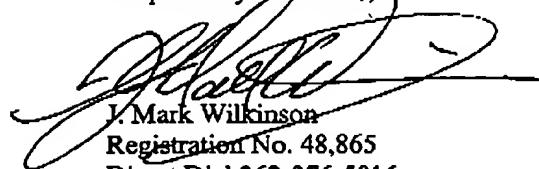
Therefore, in light of at least the foregoing, Applicant respectfully believes that the present application is in condition for allowance. As a result, Applicant respectfully requests timely issuance of a Notice of Allowance for claims 1-6, 8-13, 15-17, and 19-31.

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Applicant appreciates the Examiner's consideration of these Amendments and Remarks and cordially invites the Examiner to call the undersigned, should the Examiner consider any matters unresolved.

Respectfully submitted,



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